



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,748	10/01/1999	DANIEL SCHUTZER	CIT10127	5805

27510 7590 04/09/2002
KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
----------	--------------

2172

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary	Application No. 09/409,748	Applicant(s) SCHUTZER, DANIEL	
	Examiner HUNG Q PHAM	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The applicants amended claims 1 and 3-5 in the amendment received on 01/28/2002. The pending claims are 1-5 and 7-12. Applicants' arguments have been fully considered by the examiner. The amended limitation in claims 1, 3, 5 and new claims 7-12 are discussed in the following rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was -not commonly owned at the time a later invention was made in

Art Unit: 2172

order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey [Internet Explorer 4 for Windows for Dummies Quick Reference, ISBN 0-7645-0188-7].

Regarding to claim 1, Harvey teaches a method for searching the Web, composing and reading E-mail with Outlook Express (pages 112-114; 144-176). The Harvey method for searching comprises the steps: selecting a search engine or randomly picking a search engine by Internet Explorer 4 (pages 110-111), entering a search string for searching among the Web (page 111), clicking the **Search** button or pressing **Enter** to have the search engine begin searching its directory (page 111). This indicates the steps of receiving at least one search term and issuing a search request to a search engine using the at least one search term. When the search engine finishes processing the searching string, it returns a list of hyperlinks and user can click any of the hyperlinks in the list to display that Web page (page 112). This indicates the steps of receiving the hit list from the search engine and retrieving at least one Web page based on the hit list. To include a Web page in a new e-mail message, a user can click the **Mail** button and then choose **Send Page** from the pop-up menu (page 151). To send the e-mail message with the Web page to the recipients, click the **Send Message**. As soon as the recipients of the message open it up, they have immediate access to the

Art Unit: 2172

Web page, including all of its hyperlinks, right within the body of message (page 152).

This indicates the steps of bundling a copy of the at least one Web page into an e-mail message; and forwarding the e-mail message to an end-user's terminal wherein the copy of the at least one Web page may be reviewed by the end-user. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method to attach at least one Web page to an e-mail message by receiving the search term, issuing the search request to a search engine, receiving the hit list, retrieving the Web page, bundling the copy of the Web page into an e-mail message and forwarding the e-mail message to her user's terminal wherein the copy of the Web page may be reviewed by the user in order to send an interesting Web page to a friend or associate when a user feel they should know about.

Regarding to claim 3, Harvey teaches a method of going to the Web page of your choice, composing and reading E-mail with Outlook Express (pages 102-103; 144-176). The Harvey method for going to the Web page is to type the URL (Uniform Resource Locator) of the Web page in the **Address bar** and press **Enter** (page 102). This indicates the step of receiving an address associated with at least one Web page and retrieving the at least one Web page. To include a Web page in a new e-mail message, a user can click the **Mail** button and then choose **Send Page** from the pop-up menu (page 151). To send the e-mail message with the Web page to the recipients, click the **Send Message**. As soon as the recipients of the message open it up, they have immediate access to the Web page, including all of its hyperlinks, right within the body

Art Unit: 2172

of message (page 152). This indicates the steps of bundling a copy of the at least one Web page into an e-mail message; and forwarding the e-mail message to an end-user's terminal wherein the copy of the at least one Web page may be reviewed by the end-user. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method to attach at least one Web page to an e-mail message by receiving the address, retrieving the Web page, bundling the copy of the Web page into an e-mail message and forwarding the e-mail message to the user's terminal wherein the copy of the Web page may be reviewed by the user in order to send an interesting Web page to a friend or associate when a user feels they should know about.

Regarding to claim 4, Harvey teaches all the claimed subject matters as discussed in claim 3, and further discloses the step of including a Web page in an Outlook Express e-mail message by: clicking the **Mail** button and then choosing **Send Page** from the pop-up menu (page 151). This indicates the step of the copy of the other Web page is bundled in a second e-mail message. To send the e-mail message with the Web page to the recipients, click the **Send Message**. This indicates the step of forwarding the second e-mail message to the user's terminal. As soon as the recipients of the message open it up, they have immediate access to the Web page, including all of its hyperlinks, right within the body of message (page 152). If the current Web page contains contents that cannot be sent as part of an email message, an alert dialog box appears and asking whether to insert the URL into the mail. Choose **Yes** to add the

Art Unit: 2172

URL (page 152). These steps of Harvey method indicate the steps of generating the address based upon a request to review the at least one Web page that is linked to a copy of another Web page wherein the copy of the other Web page may be retrieved and reviewed by the user at the user's terminal. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method to include the step of generating the address, bundling the Web page in an email message, and forwarding the e-mail message to the user's terminal wherein the copy of the Web page may be reviewed by the user in order to send an interesting Web page to a friend or associate when a user feel they should know about.

Regarding to claim 9, Harvey teaches all the claimed subject matters as discussed in claim 1, but fails to disclose: the copy of the at least one Web page bundled in the e-mail message may be reviewed by the end-user when the end-user's terminal is not connected to the Web. However, Harvey teaches that after downloading a message, the messages are then downloaded to the computer (page 168). This indicates the e-mail message is just an ordinary file in the file system. Thus it can be opened and reviewed by user when the user's terminal is not connected to the Web. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method to include the technique of reviewing the e-mail message when not connecting to the Web in order to review a Web page in the body of the message.

Regarding to claim 10, Harvey teaches all the claimed subject matters as discussed in claim 1, and further discloses: the bundled at least one Web page includes a link to a non-retrieved Web page, wherein the non-retrieved Web page can be retrieved directly via connection to the Internet (page 152).

Regarding to claim 11, Lumsden and Harvey teaches all the claimed subject matters as discussed in claim 10, but fails to disclose: the non-retrieved Web page can be retrieved upon receiving another search term and issuing another search request to the search engine using the another term. However, a typo of a search term can lead to a non-result hit list and another search term has to be issued and sent to the search engine. This technique is well known in real life. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method to include the step of issuing another search request to the search engine using another term to retrieve a non-retrieved Web page in order to search a particular Web page in the WWW.

5. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lumsden [USP 6,006,217] in view of Harvey [Internet Explorer 4 for Windows for Dummies Quick Reference, ISBN 0-7645-0188-7].

Regarding to claim 5, Lumsden teaches a computer system for providing enhanced search results for searches for documents on the Internet, including a client

terminal and a server (Lumsden, Abstract and Fig. 2, Col. 4-5). In order to use the WWW, a client runs a piece of software known as Web browser (Col. 1, lines 27-28).

The Lumsden system comprises: user at client requests and receives search request form from search server; user fills out form and client returns completed request form to server as the steps of receiving at least one search term at the client terminal; bundling the at least one search term into a first message at the client terminal; forwarding the first message from the client terminal to the server (Fig. 3A, steps 100 and 102). In response to a search request from a user at a client computer, a search engine at a search server performs a search for documents at Internet sites matching the search criteria as the step of issuing the at least one search term as a search request from the server to a search engine (Lumsden, Abstract). A list of matching documents is provided to the client in the form of a hits list. For each document on the hits list, a link is provided to a server, which will provide the document to the client. This Lumsden step can be modified by excluding the step of sending the hit list to the client and keeping the hit list at the server site as the step of receiving links to a plurality of Web pages that are associated with the at least one search term at the server (Lumsden, Abstract, Fig. 3A, step 104). Lumsden fails to disclose: issuing a request for at least one of the plurality of Web pages; receiving the at least one Web page by the server; copying the at least one Web page into at least one e-mail message by the server; and forwarding the at least one e-mail message from the server to the client.

Harvey teaches a method for communicating via Internet Explorer 4 (Harvey, page 136) by composing and reading E-mail with Outlook Express (Harvey, pages 144-

Art Unit: 2172

176). The Harvey method for including a Web page in a new e-mail message is disclosed by clicking the **Mail** button and then choosing **Send Page** from the pop-up menu by a user (Harvey, page 151). To send the e-mail message with the Web page to the recipients, click the **Send Message**. As soon as the recipients of the message open it up, they have immediate access to the Web page, including all of its hyperlinks, right within the body of message (Harvey, page 152).

Thus, the Lumsden system can be modified by combining with the Harvey method of email communication. As disclosed at Fig. 3B of Lumsden, the server obtains selected document from document server at **step 110** as the step of issuing a request for at least one of the plurality of Web pages; receiving the at least one Web page by the server. And instead of forwarding the document to the client as shown in Fig. 3B **step 112**, the Web page can be forwarded to the client by e-mail by the Harvey technique of **Send Page** and **Send Message**. The modified Lumsden system by Harvey technique will indicate the step of copying the at least one Web page into at least one e-mail message by the server; and forwarding the at least one e-mail message from the server to the client.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Lumsden system to include the Harvey technique of e-mail communication in order to send a Web page to a client through the e-mail communication.

Regarding to claim 7, Lumsden and Harvey teaches all the claimed subject matters as discussed in claim 5, Harvey further discloses: the at least one Web page comprises a sub-plurality of the plurality of Web pages (Harvey, page 6-7).

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lumsden [USP 6,006,217] in view of Harvey [Internet Explorer 4 for Windows for Dummies Quick Reference, ISBN 0-7645-0188-7] and Mantha et al. [USP 6,163,779].

Regarding to claim 8, Lumsden and Harvey teaches all the claimed subject matters as discussed in claim 7, but fails to disclose: the at least one e-mail message comprises a plurality of e-mail messages, and at least one of the sub-plurality of Web pages is copied into one of the plurality of e-mail messages. Mantha teaches a method for copying and saving a Web page according to a desired category to facilitate subsequent retrieval and display of the page (Mantha, Col. 2, lines 3-5). The copy of the Web page and each of its embedded objects will be saved on a client hard drive (Mantha, Col. 2, lines 12-14) but another object of the Mantha technique is to provide a mechanism for making a copy of particular Web page content being displayed by a browser such as Netscape Navigator or Internet Explorer (Mantha, Col. 2, lines 9-11 and Col. 1, lines 23-26). Mantha further discloses: a copy of a Web page will be saved to the client local storage and several linked list for the hypertext references will be created in order to save the embedded objects of the Web page (Mantha, Col. 2, lines

45-62). Thus, instead of saving the Web page and all or its hypertext references on a local hard drive, the Mantha method can be modified to bundle the Web page and its hypertext references into an e-mail message. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method by using the technique of Mantha for copying a Web page and all of its embedded links, and instead of saving to a hard drive, a Web page and all of its embedded objects will be copied to an e-mail message in order to send an interesting Web page and all of its embedded links to a friend or associate when a user feels they should know about.

7. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey [Internet Explorer 4 for Windows for Dummies Quick Reference, ISBN 0-7645-0188-7] in view of Mantha et al. [USP 6,163,779].

Regarding to claim 2, Harvey teaches all the claimed subject matters as discussed in claim 1, and further discloses: bundling a copy of each link between the other Web page and the at least one Web page into the e-mail message (Harvey, pages 150-151), but fails to disclose: receiving a number representative of a depth in which the depth is the amount another Web page is removed from the at least one Web page. Mantha teaches a method for copying and saving a Web page according to a desired category to facilitate subsequent retrieval and display of the page (Mantha, Col. 2, lines 3-5). The copy of the Web page and each of its embedded objects will be saved on a

Art Unit: 2172

client hard drive (Mantha, Col. 2, lines 12-14) but another object of the Mantha technique is to provide a mechanism for making a copy of particular Web page content being displayed by a browser such as Netscape Navigator or Internet Explorer (Mantha, Col. 2, lines 9-11 and Col. 1, lines 23-26). The Mantha technique uses a **running counter 72** to maintain the number of copies of the embedded objects in a HTML page (Mantha, Fig. 9; Col. 10, lines 5-7). Thus, instead of saving the Web page and all or its links on a local hard drive, the Mantha method can be modified to bundle the Web page and its links into an e-mail message and use the **running counter 72** to maintain the number of copies of the embedded objects. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method by using the technique of Mantha of maintaining the number of copies of the embedded objects by a **running counter** in order to send an interesting Web page and all of its embedded links with a counter to indicate the number of the embedded links to a friend or associate when a user feels they should know about.

Regarding to claim 12, Harvey teaches all the claimed subject matters as discussed in claim 1, and further discloses: the bundled at least one Web page includes a link to another retrieved Web page (pages 150-151) but fails to teach a copy of the another retrieved Web page is also bundled into the e-mail message. Mantha teaches a method for copying and saving a Web page according to a desired category to facilitate subsequent retrieval and display of the page (Mantha, Col. 2, lines 3-5). The copy of the Web page and each of its embedded objects will be saved on a client hard drive

Art Unit: 2172

(Mantha, Col. 2, lines 12-14) but another object of the Mantha technique is to provide a mechanism for making a copy of particular Web page content being displayed by a browser such as Netscape Navigator or Internet Explorer (Mantha, Col. 2, lines 9-11 and Col. 1, lines 23-26). Mantha further discloses: a copy of a Web page will be saved to the client local storage and several linked list for the hypertext references will be created in order to save the embedded objects of the Web page (Mantha, Col. 2, lines 45-62). Thus, instead of saving the Web page and all or its links on a local hard drive, the Mantha method can be modified to bundle the Web page and its links into an e-mail message. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Harvey method by using the technique of Mantha for copying a Web page and all of its embedded links, and instead of saving to a hard drive, a Web page and all of its embedded objects will be copied to an e-mail message in order to send an interesting Web page and all of its embedded links to a friend or associate when a user feels they should know about.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Pham whose telephone number is 703-605 4242. The examiner can normally be reached on Monday-Friday, 7:00 Am - 3:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VU, KIM YEN can be reached on 703-305 4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746 7239 for regular communications and 703-746 7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305 3900.

Examiner: Hung Pham
Mar 29, 2001


HOSAIN T. ALAM
PRIMARY EXAMINER